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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,957	08/24/2001	Harald Hoepfner	3238/BDR	2134

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KATTEN MUCHIN ZAVIS ROSENMAN  
575 MADISON AVENUE  
NEW YORK, NY 10022-2585

EXAMINER
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CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/29/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/938,957

Applicant(s)

HOEPPNER ET AL.

Examin r

Alicia Chevalier

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JP  
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-- The MAILING DATE of this communication appears n the cover sheet with the corresp ndence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 8-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12. 6) ☐ Other: \_\_\_\_\_

**RESPONSE TO AMENDMENT**

1. Claims 1-18 are pending in the application, claims 8-18 are withdrawn from consideration due to Applicant's election, in paper #7 filed June 25, 2003 in response to the restriction in paper #6 mailed May 27, 2003.
2. Amendments to claims in paper #13, filed on October 16, 2003, have been entered in the above-identified application.

***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been received in paper #11, filed October 16, 2003.

***WITHDRAWN REJECTIONS***

4. The 35 U.S.C. §112 rejection(s) of claim 7 of record in paper #10, mailed July 17, 2003, pages 2-3, paragraph #4 have been withdrawn due to Applicant's amendment in paper #13.
5. The 35 U.S.C. §102 rejection of claims 1-5 and 7 as anticipated by Hardwick et al. (WO 98/56596 of record in paper #10, pages 3-5, paragraph #7 have been withdrawn due to Applicant's amendment in paper #13.
6. The 35 U.S.C. §102 rejection of claim 1, 2, 4, 6 and 7 as anticipated by Merkle et al. (US 5, 298,922) of record in paper #10, pages 5-6, paragraph #8 have been withdrawn due to Applicant's amendment in paper #13.

***NEW REJECTIONS***

7. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant application amended claim 1 contains the limitation "laser-active pigments that are doped to permit printing personalization by a laser such that said pigments become colored after laser exposure." The specification does not have support for the pigments being doped and changing color after being exposed to the laser, therefore this limitation is considered new matter.

Applicant contends that there is support for this limitation in the specification on page 2 lines 13-15 and page 5, lines 22-24. The specification on page 2, lines 13-15 recites, "[F]urther layers can, for example, be doped with materials which permit the plastic material to be personalized by means of a laser (CO<sub>2</sub>, Nd:YAG)," and on page 5 lines 21-24 recites, "[T]he coating applied in this way can consist on one or both sides of the laser-active plastic material

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which permits subsequent personalization with an Nd:YAG laser or other lasers.” The specification further recites on page 9, lines 1-3, “[T]he protective laminate can also be equipped as a multi-layer composite with integrated security features and doping suitable for laser inscription (laser engraving).”

Nowhere in these passages or any other sections of the specification is it recited that the laser-active pigments are doped. Rather the specification specifically recites that the layers, i.e. the plastic material comprising the layer, in the laminate are doped with “materials” which are suitable for laser inscription. Additionally, the specification never discloses what “materials” the layers are doped with to make the layers suitable for laser inscription.

The specification also recites on page 9, line 20 through page 10, line 2; “The blackening (imaging) is present via the thickness of the doped layer or layers of the document. In addition, it is possible to set the doping of the layers in such a way that these react to different laser wavelengths. For example, it is possible for there to be layers which react to an Nd:Yag laser and layers which for example, react to a CO<sub>2</sub> laser. Colored embodiments of lasered data (image and text data) are also possible in this way.”

There is no recitation or support in the specification that the pigments become colored after exposure to a laser. Furthermore, the only disclosure of the “laser-active pigments” in the specification is on page 5, lines 1-6; “[I]n order to achieve the object set, the invention is a multi-layered security product and a method for making the same, comprising a printable carrier material firmly joined to a plastic coating which is extruded onto the carrier material and which contains laser-active pigments and or covering film laminated onto the carrier material.”

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**ANSWERS TO APPLICANT'S ARGUMENTS**

10. Applicant's arguments in paper #13 regarding the 35 U.S.C. 112 and 102 rejections of record have been considered but are moot since the rejections have been withdrawn.

**Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Maurer et al. (US 4,579,753), Maurer et al. (US 4,597,592), Gutmann et al. (US 6,234,537), Cobben (US 6,302,444 B1), and Kulper et al. (US 6,309,724 B1) all disclose similar security articles.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0651.

ac  
12/20/03



  
**SANDRA M. NOLAN**  
**PRIMARY EXAMINER**